

III. REMARKS

Applicants respectfully submit that no new matter has been added by virtue of this amendment. The specification has been amended to insert a paragraph of related applications, and to update the status of applications previously referenced or incorporated by reference.

Claims 22-26, 28-46 and 48-61 were pending and under examination. Claims 22-26, 28-46 and 48-61 were rejected. Claims 23-24 and 43-44 have been canceled without prejudice. Claims 22, 25, 32, 42, 45-46, and 48-61 have been amended without prejudice. New claims 62-70 have been added; claims 67-70 were added merely to correct dependencies. Support for the amendments to the claims and the new claims can be found in the originally filed claims, throughout the specification and in the references incorporated by reference therein; more specifically, support can be found at page 4, lines 10-13 of the specification, in the Examples at pages 6-9 of the specification, and in WO 00/23431 which is incorporated by reference at page 1, lines 20-21 of the specification. It is respectfully submitted that no new matter has been added. Accordingly, applicants respectfully request entry of this Amendment. Claims 22, 25-26, 28- 42, 45-46, and 48-66 will therefore be pending in this application.

Rejections Under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 22-26, 28-42 and 44 as not enabled. Office Action, page 2. In this regard, the Examiner stated that “[t]he specification teaches adding terephthalic acid to fuming sulfuric acid to obtain a mixture, which is treated with 1,3,5-trioxane as opposed to the claims which teach reacting formaldehyde, such as 1,3,5-trioxane, with terephthalic acid and fuming sulfuric acid.” Id.

Applicants respectfully submit that the claims are fully enabled. The fuming sulfuric acid “represents the reaction medium”. See Specification, page 3, line 34. Thus, “reacting formaldehyde and terephthalic acid *in* fuming sulfuric acid”, as is currently claimed is enabled by applicants’ specification. “[A]dding terephthalic acid to fuming sulfuric acid to obtain a mixture, which is treated with 1,3,5-trioxane”, as characterized by the Examiner, is merely an embodiment of the present invention.

Accordingly, applicants request reconsideration and withdrawal of the rejection of the claims as not enabled.

Rejections Under 35 U.S.C. § 112, second paragraph

Claims 42-46 and 48-61 were rejected “as being incomplete for omitting essential steps.” Office Action, page 2.

Applicants respectfully submit that no essential steps have been omitted from claims 42-46 and 48-61. The Examiner stated that the omitted steps are “the process steps for the synthesis of citalopram, after synthesis of 5-carboxyphthalide”. Id. However, Applicants submit that the steps for synthesizing citalopram from 5-carboxyphthalide are familiar to those of ordinary skill in the art. For example, WO 98/019511, WO 98/019513, and WO 00/23431, now U.S. Patent No. 6,365,747 (which is incorporated by reference), all disclose steps for synthesizing citalopram from 5-carboxyphthalide. However, to expedite prosecution, applicants have amended the claims to recite the step of “using the 5-carboxyphthalide thus obtained in a process to synthesize citalopram and its acid addition salts.”

The Examiner also rejected claims 42-46 and 48-61 as lacking antecedent basis for “synthesis of citalopram”. Office Action, pages 2-3¹. Applicants have amended claims 42, 45-46 and 48-61 to correct antecedent basis, now claiming “a process for synthesizing citalopram . . .”.

In view of these remarks and the amendments to claims 42-46 and 48-61, applicants respectfully request reconsideration and withdrawal of the rejection of these claims under 35 U.S.C. §112, second paragraph.

Obviousness-Type Double Patenting Rejection

Claims 22-26, 28-42 and 44 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,458,973. Claims 42-43, 46 and 48-61 were also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-67 of U.S. Patent No. 6,703,516.

¹ The Examiner added that “Claim 22 from which the above claims depend is drawn only to the synthesis of 5-carboxyphthalide with no process steps for the synthesis of citalopram, after synthesis of 5-carboxyphthalide.” Id. Applicants would like to point out that claims 42-46 and 48-61 do not depend from claim 22; rather, claim 42 was previously amended into independent form. See October 21, 2005 Amendment and Response.

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Response dated November 5, 2006
Reply to Office Action dated May 5, 2006

In response, two terminal disclaimers are being filed concurrent with this Amendment and Response. The terminal disclaimers disclaim any term of any patent granted on the subject application which would extend beyond the expiration date of U.S. Patent Nos. 6,458,973 and U.S. Patent No. 6,703,516.

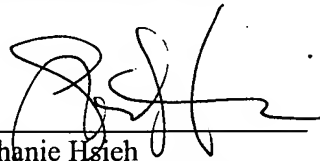
Applicants note that the obviation of an obvious-type double patenting rejection by the filing of a terminal disclaimer is not an admission, acquiescence, or estoppel on the merits of an issue of obviousness. See Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 873-74, 20 U.S.P.Q.2d 1392, 1394-95 (Fed. Cir. 1991).

In view of the submission of the two terminal disclaimers, applicants request reconsideration and withdrawal of the obviousness-type double patenting rejections of the claims.

IV. CONCLUSION

Applicants believe that this application is now in condition for allowance and respectfully request favorable action. The Examiner is invited to contact the undersigned at the telephone number below if progress of this application could be advanced.

Respectfully submitted,



Stephanie Hsieh
Registration No. 36,497

DAVIDSON, DAVIDSON & KAPPEL, LLC
485 Seventh Avenue
New York, New York 10018
212-736-1940